

REMARKS

Status of the Claims

Claims 33-45, 50-55, 57, and 58 are pending. The above amendment cancels claims 46 and 47. Claims 30-32, 42, 48, 49, 56, are currently amended.

No new matter is added in the above amendment.

Applicant notes that claims 35, 45, 47-52, 54, 55, 57, and 58 are allowable subject to removal of the 35 U.S.C. §112, first paragraph rejection.

Supervisory Patent Examiner Review Requested

As an application having received its fourth office action, Applicant respectfully requests that the present application be “carefully studied by the Supervisory Patent Examiner” pursuant to MPEP §707.02. The statement in §707.02 that the “...supervisory patent examiner should impress their assistance with the fact that the shortest path to final disposition of an application is my finding the best references on the first search and carefully applying them.” is particularly relevant in the present application. As discussed below in greater, this instant rejection is the second one in a row to apply “newly cited” prior art.

Additionally, Applicant has already filed one Request for Continued Examination (RCE). The office’s response to the RCE included a rejection that raised new prior art. See page 7 of the Office Action of January 28, 2009: “...Applicant’s arguments with respect to the cooling lines

remaining stationary when in use, have been considered but are moot in view of the new grounds of rejection..."

Applicant's subsequent response addressed this "new" prior art.

The instant rejection states that "Applicant's remarks with respect to claims 30-58 have been considered but are moot in view of the new ground of rejection." See page 8 of the outstanding office action.

Additionally, the Examiner has made an instant action final because "Applicant's amendment ("the external surface of the elongate surface of the elongate cooling medium line and internal surface of the shaft defining a cooling medium flow path out of the roll") necessitated a new grounds of rejection presented in this office action." See page 9 of the outstanding office action.

Applicant respectfully submits that the previous amendment should not have necessitated "new grounds of rejection," particularly in view of the previous claims reviewed by the Examiner, including, but not limited to, previous claim 47, for example.

The time and attention of the Supervisory Patent Examiner in expediting prosecution of this application is greatly appreciated.

Claim Objections

Claims 30, 31, 32, 42, and 56 are objected to because of minor informalities.

In view of the above amendment, this objection is moot. For example, claims 31 and 42 are amended to feature an “elongate cooling medium line conduit.”

Issues Under 35 U.S.C. §112

Claims 30-58 are rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. This rejection is respectfully traversed. Reconsideration and withdrawal thereof is requested.

Specifically, the office action alleges that the feature of “the elongate cooling medium line conduit and elbow portion remain[ing] stationary as the housing rotates” is “not described in the specification as such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.” See pages 2 and 3 of the Office Action.

Applicant respectfully disagrees with this position. Applicants submits that there should be no question to one of ordinary skill in the art that the elongate cooling medium line conduit and elbow portion remain stationary as the housing rotates. As the Examiner apparently acknowledges, page 1, lines 12-14 of the specification indicates that “a housing is mounted for rotation about the shaft and is secured to the roll rotates while the shaft remains substantially stationary.” Additionally, referring to paragraph 38 of the specification, the shaft is designed by reference number 8, which can clearly be seen in Figure 1. It is clear that this shaft remains stationary when the apparatus is in use and the housing roll rotate about the shaft. Bearings 11

enable this rotation. Accordingly, the shaft included as indicated in figure 1, parts 8a, 8b, and 8c all remain stationary when in use. Referring to paragraph 41, the shaft 8 has a first aperture in which an elbow portion 20 is mounted. Paragraph 43 states that the elbow portion, comprising annular flange which is welded or fixed to the external wall of the shaft 8. This provides a substantially liquid-tight seal. It would therefore be clear to one of ordinary skill in the art reading the specification as filed that the shaft 8 remain stationary while in use then as the elbow portion is fixedly secured to the shaft, it must also remain stationary when in use.

Even more, the conduit 24 extends into the roll 5 to convey the cooling medium into the roll as stated in the final sentence of paragraph 44. The conduit 24 is engaged with ridges 30 on the external surface on the second length 26 of the elbow portion. Accordingly, it would be absolutely clear to one of ordinary skill in the art that the conduit 24 (or elongate cooling medium line conduit as defined in the claim 1) must be secured and is immovable relative to the elbow portion when the apparatus is in use.

“[T]he ‘essential goal’ of the description of the invention requirement is to clearly convey the information that an applicant has invented the subject matter which is claimed.” In re Barker, 559 F.2d 588, 592 n.4, 194 USPQ 470, 473 n.4 (CCPA 1977). To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., Moba, B.V. v. Diamond Automation, Inc., 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); Vas-Cath, Inc. v. Mahurkar, 935 F.2d at 1563, 19 USPQ2d at 1116.

Of course, with the written description requirement, there is no *in haec verba* requirement, so newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure. Applicant respectfully submits that that is clearly the instant case.

It is well settled that the Examiner bears the initial burden of presenting a *prima facia* case of non-compliance with the written description requirement. See, for example, In re Alton, 37 USPQ2d 1578 (Fed. Cir. 1996). That burden may be met with evidence that one skilled in the art would fail to “recognize in the disclosure a description of the invention as defined in the claims’ *id.* at 1583. In the present case, the office action presents no objective evidence supported by technical journal or the like as to why one of ordinary skill in the art could not envision the “stationary” feature currently claimed.

To the contrary, as outlined above, the specification clearly satisfies the written description requirement by describing the claimed invention as sufficient detail, such that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.

Again, since the office action presents no objective evidence to the contrary, it cannot be said that the Office carried its burden.

Accordingly, Applicant specifically submit that this rejection be withdrawn.

Claims 47-52 are rejected to under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. Specifically, the Office Action alleges an insufficient antecedent basis issue in connection with claim 47 and 48.

This rejection is moot in view of the above amendment.

Accordingly Applicant respectfully submit that this rejection be withdrawn.

Issues Under 35 U.S.C. §102

Claims 30-34, 42, 43, 44, and 46 are rejected under 35 U.S.C. §102(b) as being anticipated by the “newly cited” Hunt et al. reference (U.S. patent 1,850,878; filed November 26, 1929).

This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested. However, in view of the above amendment, this rejection is moot. Claim 30 has been amended to incorporate at least portions of previously pending claims 46 and 47. Claim 47 is free from this rejection. Thus, incorporation of these features into claim 30 should automatically remove any case of anticipation. Additionally, previously independent claim 56 has been amended to also become dependent on claim 30.

Accordingly, Applicant respectfully requests that this rejection be withdrawn.

Entry of the Present Amendment

Applicants respectfully submit that the present amendment should be entered and considered by the Examiner. It should be clear that the above amendment presents no new issues that require further consideration or searching for the Examiner, particularly since the above amendment overcomes a prior art rejection by the incorporation of features of a claim that was free from the rejection.

As such, entry of the amendment is respectfully requested.

Interview Requested

Given that the outstanding rejection is the fourth issued in this application, and interview with the Examiner and her Supervisory Patent Examiner are respectfully requested to expedite allowance of this application.

From the foregoing, further and favorably reconsideration in the form of a Notice of Allowance is requested, and such action is earnestly believed to be in order.

No fee is required for this Amendment.

The Office is authorized to charge any deficiency or credit any overpayment associated with the filing of this application to Deposit Account 502752.

Finally, please contact the undersigned if there are any questions regarding this
Amendment or the application in general.

Respectfully submitted,



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